

REMARKS/ARGUMENTS

Applicants appreciate the opportunity to continue prosecution of this application, it having been returned to non-final status in response to applicants' Appeal Brief filed September 15th, 2006.

Claims 1-26 are pending and at issue in the present application. Claims 1 and 16 are independent. Claims 1, 6, 11, 16, 19, 23 and 24 are amended hereby. Certain recitations relating to database records or fields are hereby stricken from claims 6 and 11 and inserted into claim 1. Similarly, certain recitations relating to database records or fields are hereby stricken from claims 19 and 24 and inserted into claim 16. First, second, third, and fourth pluralities of, respectively, records (claims 1, 16), fields (claims 1, 6, 16, 19), pages (claims 10, 23), and templates (claims 11, 24) are now included in the indicated claims by amendments thereof in order to heighten the particularity of description of the claimed invention. No new matter has been introduced by these amendments.

Applicants acknowledge that the drawings in the case are informal. Upon allowance, formal drawings will be prepared and filed.

Claims 1-3, 5-9, and 11-26 stand rejected as allegedly anticipated by Nehab (U.S. Patent 6,029,182). Applicants respectfully traverse, as follows:

Nehab provides a method for identifying articles of interest (as defined by a user) that are published, for example, on the World Wide Web and assembling them into a single document. Nehab is not an effective Section 102 reference, however, because it does not disclose each element of the rejected claims. For example, Nehab includes no teaching of a second routine for extraction of data from a file of a first page that has portions that include content, which data are indicative of the portions and are used to generate a database where the data are stored. Moreover, Nehab does not disclose a database that includes a plurality of records and fields. Yet another deficiency of Nehab is its lack of teaching regarding the layout information of the data as it exists on the page from which it was extracted. The claimed invention, in contrast, recites that the first page description file includes "at least layout information for at least one page" (claims 1 and 16). Because each of these recitations is required for each of the allegedly anticipated claims, applicants respectfully submit that the anticipation rejection should be withdrawn.

Neither is Nehab able to properly support an obviousness rejection because, as further discussed below, it is nonanalogous art and teaches away from the claimed invention. Moreover, even if it were analogous art, the recitations noted above to be absent from Nehab are not suggested in this reference.

Claim 4 stands rejected as allegedly obvious over Simpson (Mastering WordPerfect® 5.1 & 5.2 for Windows™, pp. 539-579 and 852-859) in view of Hohensee (U.S. Patent 6,407,821). Applicants traverse. Simpson discloses using a word processor (Wordperfect®) for merging data from a database into a template document, thereby creating what is called there a “secondary merge file.” The secondary merge file described in Simpson, however, is not a page description file as that term is used in the present claims because it does not include content and layout information for one or more pages to be printed, displayed, or otherwise reproduced. Neither does Simpson disclose or suggest a first page description file that includes at least layout information for at least one page. Accordingly, Simpson fails to disclose or suggest each of the recitations found in the combination of claims 4 and 1 (upon which claim 4 depends).

Hohensee fails to cure Simpson’s defect. Hohensee discloses the direct conversion of files from Portable Document Format (PDF) to Mixed Object Document Content Architecture (MO:DCA®) format, wherein identical output pages are generated irrespective of format used. Neither Hohensee nor Simpson teach or suggest a database that includes variable content that can be inserted into one of various templates. No change in content data or its placement is contemplated in Hohensee or Simpson. Therefore, the combination of Hohensee and Simpson does not disclose or suggest each of the limitations of claims 1 and 4.

Moreover, Hohensee teaches away from the present invention to the point that it is nonanalogous art. A person of ordinary skill in the art would not have looked to the teachings of Hohensee in pursuing the present invention as Hohensee teaches tools for the opposite result sought: The present invention is a method for generating a new page description file using content data from a first page description file where the original and new page description files will appear different, *i.e.*, the output pages have differing content and/or arrangement of content. Hohensee, however, teaches a file format conversion system for generating identical output pages. In addition, the merge feature of Simpson generates a variable page from a template and a database and is only responsive to a database that is

entered by a user in comma-delimited text file format. Accordingly, the merge feature of Simpson is not responsive to files containing layout information; in particular, the secondary merge file of Simpson could not be generated from a file in PDF format. Therefore, an attempt to combine the features of Simpson and Hohensee would necessarily fail. The combination of Simpson and Hohensee far better supports the nonobviousness of the claimed subject matter rather than the Office action's contended rejection.

Applicants respectfully note that whereas the rejection of claim 4 is predicated on the combination of Simpson and Hohensee, as noted above and recited in the Office action at page 6, on page 7 thereof the rejection is explained in the context of Nehab alone. In the interest of moving the prosecution forward, applicants' attorney will respond to the obviousness rejection of claim 4 as if it were predicated on Nehab alone or on Nehab in view of Simpson and Hohensee.

First and foremost, the Nehab reference should have no effect on the present invention under Section 103 because it is not analogous art thereto. Whereas Nehab provides a method for identifying articles of interest (as defined by a user) that are published in cyberspace and assembling them into a single document (*see* Nehab Abstract, *inter alia*), the present invention relates to a method and system for automated production of a customized page description file. The customized page description file is generated irrespective of the source of a first page description file from which data are extracted for the customized one. *See* specification at 1-3. The "finding" or "retrieving" of the first page description file is not at issue in the present invention; rather, making use of the data included in that file is.

In contrast, Nehab is a "data retrieval system" for identifying and retrieving "articles from a news service, from a magazine service, or from a combination of both services which are located on the World Wide Web, a private computer network that supports hypermedia links, or any other hypermedia-linked computer system." Nehab at col. 1, ll. 8-17. At its essence, Nehab provides a method for downloading articles of interest (*i.e.*, data) by searching a series of identified sites, linking the respective data together thereby avoiding hypermedia-links, storing the data in a linear document, and formatting the data into a personalized document. *Id.* at col. 3, ll. 15-65.

For creating a new page description file that differs in its organization, but includes the same content data, or a subset thereof, which are two of many examples of use of the

present invention, the routineer seeking technical insights would naturally look at literature directed at methods of manipulating already-identified data. Applicants respectfully submit that the routineer would not have considered methods for identifying and retrieving content data of interest from sites across the World Wide Web as likely providing useful insight to the problem of creating, for example, specialized catalogs from larger, broader catalogs, for example. Accordingly, Nehab is nonanalogous art that should be dismissed.

Even if Nehab is not dismissed as nonanalogous art, it should be seen to support the nonobviousness of the present invention because it teaches away from the claimed invention. For example, Nehab at column 12, lines 1-16 describes a step of “data exclusion” by which information identified by a Web reader is limited. Indeed, a substantial amount of description in Nehab relates to steps for flattening and formatting extracted data, which “provides an opportunity for excluding more data from the personalized newspaper....” Nehab at col. 12, ll. 49-50. In contrast, the present invention includes a method where the information of interest is defined by the fact of being included in the first page; no data exclusion step is recited.

Because claim 4 depends upon claim 1, the failings of Nehab to teach claim 1 that are set forth above obtain for claim 4 as well. Further, because Nehab does not suggest layout information for extracted data as they existed on the page from which they were extracted, as one example of Nehab’s failings, Nehab alone cannot render claim 1 or dependent claim 4 obvious. Neither does Nehab disclose or suggest a database having a plurality of records and a plurality of fields, as recited by all claims of applicants’ application.

Nehab cannot be cured by the addition of Simpson or Hohensee, or the combination of Simpson and Hohensee. Simpson relates to methods for mail merge using a word processor and two sources of data; Hohensee relates to methods for printing a document having embedded objects without need of reformatting. Neither Simpson nor Hohensee, taken individually or in concert, disclose or suggest layout information for the extracted data as they existed on the page from which they were extracted. Accordingly, applicants respectfully submit that the obviousness rejection of claim 4 should be withdrawn.

Claims 10 and 23 stand rejected as allegedly obvious over Nehab in view of Mastie (U.S. Patent 6,480,866). Applicants respectfully traverse this rejection, as follows: Nehab, as noted above, should be dismissed as nonanalogous art relative to the pending claims.

Moreover, Nehab fails, in part, to disclose or suggest layout information for the extracted data as they existed on the page from which they were extracted. Mastie cannot cure this defect as it does not disclose or suggest that it would have been desirable or even possible to extract data from a first page description file to generate a database for storing the extracted data, wherein the first page description file includes at least layout information, or both content and layout information, or to provide a routine that accomplishes this function, as set forth in all pending claims. Accordingly, the obviousness rejection of claims 10 and 23 should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the various rejections of the claims at issue and reconsideration thereof are respectfully requested.

Deposit Account Authorization

The Commissioner is hereby authorized to charge any deficiency in any amount enclosed or any additional fees which may be required during the pendency of this application under 37 CFR 1.16 or 1.17, except issue fees, to Deposit Account No. 50-1903.

Respectfully submitted,

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Date: March 12, 2007

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